

Appl. No.: 09/890,696
Amendment Dated: November 1, 2005
Reply to Office Action of 08/02/2005

Remarks

Claims 11 and 20 have been amended to correct the formulae appearing therein. Additionally, in Claim 12 the word “and” has been substituted for the word “or.” In Claim 20, in addition to the correction of the formula, minor corrections have been made to correct typographical errors.

Claims 11-17 and 20 stand rejected as obvious over Lerg et al. (Lerg) in view of Balzer and Bergmann et al. (Bergmann) in further view of Ansmann et al. (Ansmann). The rejection is again respectfully traversed. At the outset, Applicant hereby incorporates by reference the remarks accompanying the communication filed on 16 May 2005.

Lerg discloses a composition comprising:

- (1) an oil component, e.g., carboxylic acid esters of glycerol,
- (2) TIPA laureth sulphate, and
- (3) optionally, propylene glycol.

Perhaps more importantly, Lerg teaches that a content of 3.5 % by weight at most, based on the total weight of the preparation of water, can be present in the composition. This is to be contrasted with Applicant’s Claims 11 and 20 which call for 20 to 95 % by weight water. Furthermore, Lerg requires 30 to 45 % by weight of an oil component (see column 2, lines 37-43). Applicant’s composition on the other hand calls for an oil component content of 20 % by weight and less.

Lerg does not disclose Applicant’s claimed microemulsion but rather conventional, non-transparent emulsions, even when the compositions are diluted. Simply stated, Lerg does not mention microemulsions. In an attempt to cure the deficiencies of Lerg vis-à-vis a composition with a substantial amount of water and in the form of a microemulsion, the Examiner resorts to the secondary references to Balzer, Bergmann and Ansmann. Basically, the Examiner has used the secondary references to supply the teaching of using an emulsifying agent to form microemulsions (Balzer/Bergmann) or for the teaching of diluted cosmetic or pharmaceutical emulsions using alkenyl (ether) sulphate (Ansmann).

The issue is whether the combination of the references, as viewed by the Examiner, makes out a *prima facie* case of obviousness. The answer to that question is unequivocally “no.” The

Appl. No.: 09/890,696

Amendment Dated: November 1, 2005

Reply to Office Action of 08/02/2005

Examiner does not argue, nor would it be possible to argue, that the ranges disclosed in Lerg vis-à-vis the water/oil content are the same as, overlap with, or are even close to those set forth in Applicant's Claims 11 and 20. Rather, the Examiner's rejection based on the combination of Lerg and the secondary references, is buttressed on an 'obvious to try' standard, a position which has been repeatedly condemned by the Federal Circuit. In the eyes of the Examiner, and despite the fact that the composition disclosed in Lerg differs dramatically from that in Claims 11 and 20, the Examiner simply takes the position that it would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to dilute the composition of Lerg et al. with water and formulate a microemulsion. In *N.V. Akzo v. E.I. duPont de Nemours & Co.*, 810 F.2d 1148, 1151 1 USPQ 2d 1704, 1707 (Fed. Cir. 1987) the Court said:

"Of course, an 'obvious to try' standard is not a legitimate test of patentability . . . the statutory standard of §103 is whether the invention, considered as a whole, would have been obvious to one skilled in the art, not whether it would have been obvious to one skilled in the art to try various combinations". (emphasis supplied)

The latter is exactly what the Examiner is suggesting, i.e., that it would have been obvious to one of skill in the art to try diluting Lerg and forming it into a microemulsion. The problem with that scenario is that:

- (1) it is not a test of *prima facie* obviousness, and
- (2) the Examiner has failed to point to any motivation for the skilled artisan to even make the attempt.

See also, *L&P Engineering Plastics, Inc. v. Miller Waste Mills, Inc.*, 77 F.2d 514, 556 (Delaware 1999, *aff'd in part, rev'd in part*, 275 F.3d 1347, 61 USPQ 2d 1193 (Fed. Cir. 2001) to the effect that:

"Evidence that it would have been 'obvious to try' a given invention is insufficient to support a finding of obviousness . . . an 'obvious to try' situation exist when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result." (emphasis supplied)

Appl. No.: 09/890,696

Amendment Dated: November 1, 2005

Reply to Office Action of 08/02/2005

This is exactly the case here. Perhaps the general disclosure of Lerg coupled with the other references may pique the scientist's curiosity, but it is abundantly clear that the references do not contain a sufficient teaching of how to obtain the desired results absent resort to Applicant's disclosure which, as the Examiner knows, is forbidden hindsight analysis.

Furthermore, a *prima facie* case based on Lerg is all the more untenable when one considers that Lerg specifically teaches in column 2, lines 1-6:

"A significant disadvantage of bath preparations is that they are present in very diluted form since a bath tub can in some circumstances hold up to several hundred liters of water."

That can be construed as nothing more than a teaching against diluting the Lerg compositions.

The Examiner's position regarding the secondary references is also untenable. For example, the emulsions of Balzer require the presence of at least 80 % by weight alkyl polyglycosides (APG). This requirement of 80 % by weight APG is contradictory to the teaching of Lerg that requires at least 30 % by weight of an oil component and nowhere in Lerg is APG suggested as a further surfactant. Accordingly, the teachings of Lerg and Balzer simply cannot be combined.

Indeed the skilled artisan looking at the Lerg and Balzer references would conclude that they teach away from Applicant's invention as set forth in Claim 11 because:

- Balzer requires at least 80 % by weight APG based on the sum of APG and co-surfactants,
- A different co-surfactant from the many ones mentioned in column 3 may be selected, and
- The use of mono- or polyvalent C₂ to C₂₄ alcohols is not suggested.

Balzer does mention alkyl sulphates or alkyl ether sulphates in a long list of possible co-emulsifiers. A C₂ – C₃ – alkenol ammonium is one cation among numerous mentioned and there is no connection between the alkyl sulphates or alkyl ether sulphates in C₂ – C₃ – alkenol ammonium. Nowhere is the compound (A) with R⁴ equal isopropanol, as set forth in Claim 11 mentioned.

Furthermore, Balzer does not teach the presence of mono- or polyvalent C₂ – C₂₄ – alcohols. Alkylpolyglycocides (APG) are not "polyvalent C₂ – C₂₄ – alcohols" as APG's fall under Category

Appl. No.: 09/890,696

Amendment Dated: November 1, 2005

Reply to Office Action of 08/02/2005

(E), i.e., further surfactants (see Claim 14) of the present application.

Since Claim 20 includes the language “wherein no compound falls under two categories at the same time” APG cannot fall under (D) and (E) at the same time and must be clearly (D) only. With respect to the Bergmann reference, that patent is merely cumulative of Balzer with the exception that triethanolamine salts of lauryl sulphate and lauryl ether sulphate are mentioned amongst numerous other surfactants. However, neither Claim 11 or 20 contains any mention of triethanolamine salts.

Furthermore, the above-mentioned compounds in Bergmann do not form a microemulsion and are only part of a composition comprising a cleansing surfactant to which a microemulsion may be added (column 18, lines 34-46). Furthermore, Bergmann does not disclose whether an oil component in the amount specified in Claim 11 is part of the composition and polyols are mentioned as a further optional ingredient of the emulsion of Bergmann but not with reference to component (A) of Claim 1. It is simply impossible to combine the teachings of Lerg with Bergmann as Bergmann requires significant amounts of water to be present (column 18, lines 5-6).

Claims 11-17 and 20 stand rejected as obvious over Hermann et al. in view of Balzer and Bergmann and in further view of Ansmann. This rejection is likewise respectfully traversed. As recognized by the Examiner, Hermann suffers from the same infirmities of Lerg and Applicant's remarks above with respect to the failure of the references to make out a *prima facie* case of obviousness are equally applicable here. Additionally, and for the same reasons pointed out above, the secondary references cannot be combined with Hermann in any manner to arrive at Applicant's claimed compositions without resort to Applicant's disclosure.

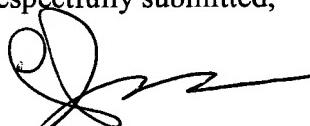
It is apparent from the Examiner's rejection of the claims that Applicant's disclosure has been used as a recipe in an attempt to pick and choose various components from the disclosures of the primary and secondary references in an attempt to arrive at the Examiner's position that Applicant's claims are obvious. However, a rejection based on that exercise cannot be sustained. Once again Applicants point to the fact that the oil/water ranges set forth in Applicant's claims versus those set forth in either Lerg or Hermann are so far removed from one another as to negate any *prima facie* case of obviousness. Applicant is well aware of case law where (1) overlapping

Appl. No.: 09/890,696
Amendment Dated: November 1, 2005
Reply to Office Action of 08/02/2005

ranges, (2) even a slight overlap in ranges, and (3) ranges that do not overlap but are close, have been held to make out a prima facie case of obviousness. Indeed Applicant is even aware of case law that selecting a narrow range within a somewhat broader range can make out a prima facie case of obviousness. However, Applicant is aware of no case and the Examiner has not cited any case wherein when the ranges of the claimed components were so vastly dissimilar from the prior art that none of the above 3 scenarios fit and where it was still held that a prima facie case of obviousness was established.

It is respectfully submitted that all claims are in condition for allowance which is hereby earnestly solicited and respectfully requested.

Respectfully submitted,



C. James Bushman

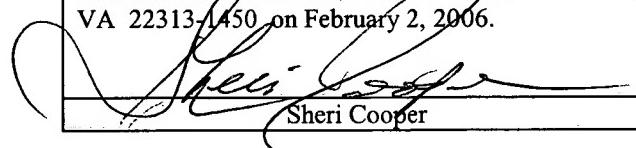
Reg. No. 24,810

Date: February 2, 2006
BROWNING BUSHMAN P.C.
5718 Westheimer, Suite 1800
Houston, TX 77057-5771
Tel.: (713) 266-5593
Fax: (713) 266-5169

C:\client_cth\cjb\muller\27-1amendment_finaloa.doc

CERTIFICATE OF MAILING

I certify that this document is being deposited with the United States Postal Service as Express Mail with Receipt No. EV 317504575 US Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 2, 2006.



Sheri Cooper